

Notice of Allowability

Application No.

10/565,739

Applicant(s)

TAGAWA ET AL.

Examiner

Art Unit

VISHAL VASISTH

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to submission filed on 1/21/2011.
2. ☒ The allowed claim(s) is/are 1,4,6,8-13 and 17.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>2/1/2011</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date <u>6/9/2010 and 7/15/2010</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

/Vishal Vasisth/ 2/1/2011

DETAILED ACTION

1. Applicants' response filed on 1/21/2011 amended independent claims 1 and 10, dependent claims 4, 6, 8-9, and 13, and cancelled claims 5, 7 and 14-16. Applicants' amendments in light of their arguments are persuasive and, therefore, the claim objections, and the 35 USC 103 rejection over Kawahara in view of Shimomura from the office action mailed on 8/23/2010 is withdrawn. Applicants did not submit translations to the non-patent literature documents from the IDS' filed on 6/9/2010 and 7/15/2010 therefore these documents have been placed in the file but have not been considered. For the reasons stated below, claims 1, 4, 6, 8-13 and 17 are in allowable condition.

Information Disclosure Statement

2. The information disclosure statements filed on 6/9/2010 and 7/15/2010 fail to comply with 37 CFR 1.97(c) because the non-patent literature documents, Japanese Office Actions dated 5/11/2010 and 6/29/2010, lack a statement as specified in 37 FR 1.97(e). They have been placed in the application file, but the information referred to therein has not been considered.

Examiners Amendment

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

A) At the beginning of line 1 on page 1 of the specification:

Please ADD the phrase, "This application is a 371 of PCT/JP04/10840, filed July, 29th, 2004.

B) From claims 1 and 10:

Please CANCEL "polyol esters" and "polyoxyalkylene glycols" from the list of base oils.

Spoke with Hojung Cho on 2/1/2011 and she approved the above mentioned amendments.

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Allowable Subject Matter

4. The following is an examiner's statement of reasons for allowance:

As evidenced by the prior art references of record, it is well known in the art for refrigeration compositions to comprise base oils, phosphorothionates, phosphates, oiliness agents and additional additives. Applicants', however, have amended their claims to "consisting of" language which means that the claims are close-ended and additional additives besides the ones enumerated in the claims cannot be present in the prior art compositions.

Kawahara discloses base oils as necessary components that are derived from branched-chain carboxylic acids which are not recited in instant claims 1 and 10.

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Shimomura discloses alicyclic polycarboxylic acid ester base oils which is not among the base oils recited in instant claims 1 and 10.

Schnur discloses polyol esters as necessary base oils in the composition which is not among the base oils recited in instant claims 1 and 10.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Glenn A Caldarola/
Supervisory Patent Examiner, Art
Unit 1771